

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

TI-28564.1

Sundararajan Sriram

Examiner: **Casca, Fred**

Serial No.: **10/658,902**

Art Unit: **2617**

Filed: **09/10/2003**

Conf. No.: **3595**

For: **COMMA FREE CODES FOR FAST CELL SEARCH USING
TERTIARY SYNCHRONIZATION CHANNEL**

**REQUEST FOR RECONSIDERATION BY THE COMMISSIONER OF
DECISION DISMISSING PETITION TO WITHDRAW HOLDING OF
ABANDONMENT -- 37 C.F.R. §§ 1.181**

Mail Stop Petition

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests reconsideration by the Commissioner of the Decision on Petition dated December 23, 2009 dismissing Applicants' Petition to Withdraw the Holding of Abandonment, for the reasons set forth below.

In the Decision on Petition dated December 23, 2009 DISMISSING Applicant's Petition, the Office of Petitions set forth the following grounds for dismissing the Petition:

Petitioner is advised that the document known as ATTACHMENT-5 while a docket record, it is as stated by petition as a "list of the docket for the pending application". The requirement however to show non-receipt under *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971) is for the "Master Docket" and not a docket record for the pending application.

Applicant respectfully disagrees with the DISMISSAL of the Petition for the reasons set forth below.

**REASONS WHY THE DECISION ON PETITION DISMISSING THE
PETITION IS IN IMPROPER AND SHOULD BE WITHDRAWN**

The Decision on Petition dated November 17, 2008 held that copies of the "DOCKET RECORDS" were required -- NOT a "physical copy of the entire contents of the actual file jacket" (see Decision on Petition dated November 7, 2008, page 1, lines 25-29).

Yet the Decision on Petition dated December 23, 2009, determined "a petition filed November 20, 2007 and treated under 37 CFR 1.181 was dismissed in a decision mailed June 10, 2008 because the requirement under 37 DFR 1.181, that copies of the ACTUAL docket records OR FILE JACKET be provided, was not met" (Decision on Petition dated December 23, 2009, page 1, lines 19-22).

After first determining that that a "physical copy of the entire contents of the actual file jacket" was not required -- ONLY "DOCKET RECORDS" (see Decision on Petition dated November 7, 2008, page 1, lines 25-29), the USPTO has now changed its grounds for dismissing the petition by now determining that a "Master Docket" is required -- NOT a docket record (see Decision on Petition dated

December 23, 2009, page 1, line 30 – page 2, line 3). The two Decisions are at odds with one another and confusing.

The Decision on Petition dated December 23, 2009, page 2, lines 1-3, cites Delgar v. Schulyer, 172, USPQ 513 (D.D.C. 1971) as requiring that Applicants present a “Master Docket” – and NOT a docket record for the pending application. The USPTO’s understanding of Delgar v. Schulyer, however, is only partially correct. Delgar v. Schulyer, actually states:

A copy of the practitioner’s record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, **a copy of the master docket report** showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. **If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.**

The first issue to resolve is what comprises a “Master Docket” in the context of the Delgar v. Schulyer holding? Delgar v. Schulyer states:

A copy of the practitioner’s record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a **three month period for reply was set** in the nonreceived Office action, **a copy of the master docket report** showing all replies docketed **for a date three months from the mail date of the nonreceived Office action** must be submitted as documentary proof of nonreceipt of the Office action.

The document in dispute, "Notice to File Corrected Application Papers" lists a notification date of July 9, 2007 and sets forth a reply date of "up to 30 days from the mail date of the Notice to correct the listed informalities". Thus, under the holding in Delgar v. Schulyer, a "Master Docket Report" in the present situation would comprise a docket reports showing all USPTO responses docketed for Texas Instruments Incorporated USPTO patent applications for August 8, 2007 - a date 30 days from the July 9, 2007 notification date of the document "Notice to File Corrected Application Papers".

Applicant submits herewith a document (ATTACHMENT-14) that is a docket report showing all USPTO responses docketed for Texas Instruments Incorporated USPTO patent applications for August 8, 2007 - a date 30 days from the July 9, 2007 notification date of the document "Notice to File Corrected Application Papers". Attachment-14 qualifies as a "Master Docket Report" under Delgar v. Schulyer. The submitted "Master Docket Report" clearly shows that NO responsive action was docketed for US Application No. 10/658,902 (TI-28564.1 or T28564.1) on August 8, 2007, thus confirming non-receipt of the "Notice to File Corrected Application Papers" listing a notification date of July 9, 2007 and setting forth a reply date of "up to 30 days from the mail date of the Notice to correct the listed informalities", by Applicant and/or Texas Instruments Incorporated.

Having submitted herewith the newly requested "Master Docket", no additional evidence of non-receipt is required under Delgar v. Schulyer.

But even if Applicant had not been able to produce the attached "Master Docket Report", the court in Delgar v. Schulyer, used the term "should" -- and not "shall" or "must" -- in its determination that "a copy of the practitioner's record(s) required to show non-receipt of the Office action **SHOULD include the master**

docket for the firm". Thus, submission of a "Master Docket" is not mandatory. Delgar v. Schulyer goes on to state, that where a "Master Docket" does not exist, **"the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; OR the individual docket record for the application in question"**.

Applicant has already provided an individual docket record for the present application (see ATTACHMENT-5). The USPTO has admitted that ATTACHMENT-5 is an individual docket record for the present application (Decision on Petition, dated December 23, 2009, page 1, line 30 -- page 2, line 3). Thus, Applicant has already met the alternative requirements of Delgar v. Schulyer, where no "Master Docket" exists. The docket record by itself is sufficient evidence under Delgar v. Schulyer, to show non-receipt of the Office communication dated July 2, 2007 (note use of the term "OR" -- NOT "AND" -- thus any one form of the listed evidence may be an acceptable substitute for "Master Docket" under Delgar v. Schulyer).

In addition to the above docket record, Applicant previously provided as additional evidence of non-receipt: 1) incoming mail logs for July 6-13, 2007 (ATTACHMENTS - 8-13)(which shows non-receipt by TI of the July 9, 2007 Office letter); and 2) the Declaration of Sharlet Hurst dated July 17, 2008, U.S. Patent Docketing Administrative Assistant tasked with the duty of logging into Texas Instruments' legal data base all incoming communications to Texas Instruments from the USPTO during the time period in question (declaring that no Office letter dated July 9, 2007 for the above-identified application was received by Texas Instruments prior to the copy attached to the Decision on Petition dated June 10, 2008).

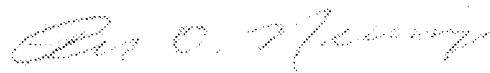
Thus Applicant has already provided two alternative forms of evidence of non-receipt (as identified by Delgar v. Schulyer) of the Office letter dated July 9, 2007, where any one should be sufficient under Delgar v. Schulyer. In addition to the above, Applicant has submitted the declaration of the TI docketing clerk affirming that the Office letter dated July 9, 2007 was not received by TI prior to the copy attached to the Decision on Petition dated June 10, 2008. Surely three separate alternative forms of evidence of non-receipt, when Delgar v. Schulyer, requires only one, should be sufficient.

In addition to the above, Applicant notes for the record that he has not submitted a copy of the actual application file jacket for U.S. Application No. 10/658,902 because the Decision on Petition dated November 7, 2008 specifically stated that a "physical copy of the entire contents of the actual file jacket" was NOT required (page 1, lines 25-29). Applicant has already provided three alternative forms of evidence of non-receipt of the Office letter dated July 9, 2007, when Delgar v. Schulyer, holds that any one form can be sufficient.

Thus the determination by the Office of Petitions that -- "Evidence of non-receipt under Delgar v. Schulyer has not been met" (Decision on Petition dated December 23, 2009, page 2, lines 1-3)", is clearly in error and must be withdrawn.

Accordingly, in light of the above facts and arguments, Applicant respectfully requests reconsideration of the Dismissal of the Petition dated December 23, 2009, and hereby reaffirms his request that the Petition request be granted.

Respectfully submitted,



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MASTER RESPONSIVE ACTION DOCKET FOR TEXAS INSTRUMENTS FOR 08-08-2007

Response Due Date	Action	PTO Completed Date	Action Notes	Attorney	Docket Number	Country	Case Type	Relation Type	Filing Type	Filing Number	PATENT MASTER ID
8/8/2007	Abandon?			ST	129593	US	Regular	Division	National		84330
8/8/2007	ROW Amendment			DD	116260	JP	Regular	Original Filing	National		47359
8/8/2007	Response 3rd office action	7/30/2007		JG	118925	JP	Regular	Original Filing	National		54455
8/8/2007	Response to 1st office action			RON	121984	JP	Regular	Original Filing	National		63099
8/8/2007	Pay Grant Fees			JEM	125595	KR	Regular	Original Filing	National		74592
8/8/2007	3rd Office Action Extension		for received - eot allowed - 3 oa - 8 feb 07 + 6 months	RON	130718	EP	Regular	Original Filing	European Patent Case		76695
8/8/2007	Appeal brief - 1 month extensi	8/17/2007		RON	131761	US	Regular	Original Filing	National		78507
8/8/2007	Response to 1st office action	8/8/2007		WJB	132603	JP	Regular	Original Filing	National		79685
8/8/2007	Drawings due - 1 month			WLF	132942	US	Regular	Original Filing	National		80179
8/8/2007	2nd Office Action Extension		for received - eot allowed - 2 oa - 8 Feb 07 + 6 months	RON	133657	EP	Regular	Original Filing	European Patent Case		81194
8/8/2007	Drawings due - 1 month			AKS	139701	US	Regular	Original Filing	National		90499
8/8/2007	Final rejection - 2nd extensio	11/9/2007		WLF	138727	US	Regular	Original Filing	National		90530
8/8/2007	Amendment 116 due	8/8/2007		CAB	162970	US	Regular	Original Filing	National		96487

MASTER RESPONSIVE ACTION DOCKET FOR TEXAS INSTRUMENTS FOR 08-08-2007

8/8/2007	Abandon?	RON	T33042	US	Regular	Original Filing	National	86023
8/8/2007	Art Cite	SAS	T38120	US	Regular	Original Filing	National	91543
8/8/2007	Drawings due - 1 month	AKS	T37507	US	Regular	Original Filing	National	88844
9/8/2007	1st Office Action Extension	WBK	T38884	EP	Regular	Original Filing	European Patent Case	93799
8/8/2007	Natl Filing Ext (CHAP II)	WLF	T38979	WO	Regular	Original Filing	Patent Cooperation Treaty	94443
8/8/2007	Natl Filing Ext (CHAP II)	WLF	T39686	WO	Regular	Original Filing	Patent Cooperation Treaty	94801
8/8/2007	Intnl Exam Report	WLF	T39402	WO	Regular	Original Filing	Patent Cooperation Treaty	95387
9/8/2007	Application NP from Provisional	CAB	T62576	US	Provisional Special	Original Filing	National	95930
8/8/2007	Issue Fee Due	CAB	T63027	US	Regular	Continuation	National	96616
9/8/2007	Drawings Required or Due	CAB	T63027	US	Regular	Continuation	National	96616
9/8/2007	Issue Fee Due	CAB	T63050	US	Regular	Original Filing	National	96652
8/8/2007	Drawings Required or Due	CAB	T63050	US	Regular	Original Filing	National	96652
9/8/2007	Petition or Request For Exam	RAK	T34806	KR	Regular	Original Filing	National	97232
8/8/2007	Application NP from Provisional Special	CAB	T62575	US	Regular	Original Filing	National	98620

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8/8/2007	Info Disc. Statement	LJB	T19785	US	Regular	Division	National	03	99692
8/8/2007	Info Disc. Statement	JJP	T62553	US	Regular	Original Filing	National		99693
8/8/2007	Info Disc. Statement	MGA	T61765	US	Regular	Original Filing	National		99694
8/8/2007	Info Disc. Statement	WLF	T33340	US	Regular	Division	National	01	99695
8/8/2007	Info Disc. Statement	WJB	T37102	US	Regular	Division	National	01	99696
8/8/2007	Info Disc. Statement	WLF	T37691	US	Regular	Division	National	01	99697
8/8/2007	Info Disc. Statement	ST	T61140	US	Regular	Continuation	National	01	99698
8/8/2007	Info Disc. Statement	ST	T61140	US	Regular	Continuation	National	01	99698
8/8/2007	Info Disc. Statement	CAB	T29655	US	Regular	Division	National	02	99848
8/8/2007	GB Disclosure Request	MH	T63541	GB	Regular	Original Filing	National		100042
8/8/2007	GB Disclosure Request	MH	T63555	GB	Regular	Original Filing	National		100043
8/8/2007	File By Due Date	INT	T62575	WO	Regular	Original Filing	Patent Cooperation Treaty		100294
8/8/2007	ROW Pre-filing Amendment	INT	T62575	WO	Regular	Original Filing	Patent Cooperation Treaty		100294
8/8/2007	Address for Service Recorded	WLF	T35149	GB	Regular	Original Filing	European Patent Case		100607

MASTER RESPONSIVE ACTION DOCKET FOR TEXAS INSTRUMENTS FOR 08-08-2007

8/8/2007	File By Due Date	8/8/2007	INT	T62363	WO	Regular	Original Filing	Patent Cooperation Treaty	100533
8/8/2007	ROW Pre-filing Amendment	8/8/2007	INT	T62363	WO	Regular	Original Filing	Patent Cooperation Treaty	100533
8/8/2007	Natl Filing To Be Requested	9/29/2007	MGA	T35853	CN	Regular	Original Filing	Patent Cooperation Treaty	100505
8/8/2007	ROW Natl Stage Entry Amendment	9/29/2007	MGA	T35853	CN	Regular	Original Filing	Patent Cooperation	100905
8/8/2007	Rejection response due	11/9/2007	CP	T35853	US	Regular	Original Filing	National	87325